

REMARKS

Claims 8-33, 48-49, 51-52, and 71-90 are now pending in this application.

Claims 8-19, 21-29, 31-32, 48-49, 51-52, and 71 90 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Pat. No. 6,014,643, to Minton, in view of "Dialog" (that is, an article found on the Dialog database, entitled "Hambrecht & Quist Selects Stratus, TCAM for On-Line Brokerage Application"). These rejections are respectfully traversed.

Applicants incorporate herein by reference and respectfully repeat the arguments made in the earlier responses filed in this case, to the extent that they are directed to the same references as are cited herein.

Minton is cited for allegedly disclosing all limitations of claim 8 except for the "automatic updating" limitation – that is, the limitation that "at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates." The Patent Office has conceded in several Office Actions that Minton does not disclose the automatic updating limitation.¹ The Patent Office has unsuccessfully tried to cite other references that disclose this limitation and then argue that one of ordinary skill in the art at the time of the invention would be motivated to combine the teachings of such references with Minton. In the present Office Action, the Patent Office's candidate for this role is "Dialog" Once again, the cited reference fails to disclose the limitation for which it is cited – that is, it fails to disclose the automatic updating limitation.

The Office Action states (at page 3, second paragraph) that Dialog "teaches automatic real time update of open orders." But the Patent Office has misread Dialog. There is no mention in Dialog of automatic updating of any information displayed to a user. The words "automatic" and "automatically" appear in the article, as well as the word "update." But Dialog does not use the word "update" in conjunction with the words "automatic" or "automatically." The only things mentioned in Dialog as being done automatically are trade execution (see second and fourth paragraphs), trade reporting to NASDAQ (see fourth paragraph), and trade recording in a database (see fourth paragraph). Dialog does not mention real-time updating of displayed information being done automatically. Thus, the claim rejections that rely on Dialog are improper, and should be withdrawn. In the present Office Action, that means that all claim rejections should be withdrawn.

¹ Other deficiencies of Minton and Tull have been discussed in previous responses filed in this case, the entire contents of each of which are incorporated and reiterated herein by reference.

Further, the combination of Minton and Dialog, or Minton, Dialog, and Tull, does not result in the claimed invention. For example, as the Patent Office admits at page 9 of the Office Action, none of the cited references, either alone or in combination, discloses displaying data relating to a user's positions or account balances being updated in real-time. The mere assertion that a person of ordinary skill in the art would find updating such information in real-time desirable is not sufficient to render claim 74, for example, unpatentable. The question is not whether such a feature was desirable; the question is whether there was some teaching in the art as to *how to do it*. Applicants improved existing software paradigms that previously had been incapable of providing such individualized securities trading account information to a plurality of users on a real-time basis. Simply put: others may have wanted to do it, but Applicants were the first to do it. Desirability of a feature demonstrates a long-felt need, which weighs against obviousness.

Consequently, the statement by the Patent Office that "it would have been obvious to a person of ordinary skill in the art to incorporate data relating to positions and account balances are updated in real-time into Minton and Dialog so that a trader can see which market maker is buying or selling stock and at what volumes" is not a proper ground for an obviousness rejection. The quoted statement is merely an assertion that such features would be recognized as desirable; it does not demonstrate that the ability to create such features was known. Importantly, however, the quoted statement is also inaccurate, since the account balances and positions being displayed are those of the user viewing the display (i.e., of the "trader") - not of market makers. This point was discussed in a previous response. To put the point respectfully but much more bluntly this time: the asserted ground for the missing limitation of claim 74 being obvious is nonsensical.

Claims 20, 30, and 33 are rejected over Minton and Dialog, further in view of U.S. Pat. No. 6,092,056, to Tull, Jr. et al. ("Tull"). These rejections are respectfully traversed.

In light of the above-discussed deficiencies of Dialog, the rejections of claims 20, 30, and 33 over Dialog are improper and should be withdrawn. Further, as discussed in previous responses, Tull is non-analogous art. And of course there was no suggestion or motivation in the prior art to combine Tull with the combination of Dialog and Minton, since the combination of Dialog and Minton did not exist.

Also, Tull is cited as disclosing “displaying the performance of a financial instruments ‘securities’.” This statement occurs twice on page 13 in the Office Action, but Applicants are unsure of its meaning. Clarification is respectfully requested.

Finally, at page 4 the Office Action states: “Official Notice is taken that it is old and well known in the trading art for trader to entering counter offers in an electronic form during a negotiating process and before offers can be accepted.” As best understood, Applicants respectfully traverse this taking of official notice. If the limitation of claim 13 was well known, Applicants respectfully submit that it would have been mentioned in the cited references (particularly in Minton, which is alleged to disclose such a negotiation process). As admitted in the Office Action, it is not disclosed in those references. Thus, pursuant to MPEP § 2144.03(C), Applicants respectfully request the Patent Office to either (a) provide documentary evidence for the alleged facts of which Official Notice has been taken, or (b) withdraw the allegation in the next Action.

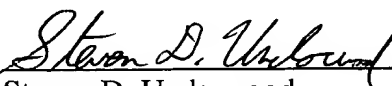
Applicants also respectfully call attention to MPEP 707.07(g), which specifies that piecemeal examination should be avoided as much as possible, and that each claim should be rejected on all valid grounds available. In the present case, the claims have been rejected numerous times, almost always over a different reference or set of references each time: for example, Ferstenberg and Minton in the January 30, 2001 Action; Lupien, Minton and “Personal Finance” in the July 13, 2001 Action; Minton and Dialog/T. Rowe Price in the April 11, 2002 Action; Minton and Stokes in the October 3, 2002 and April 9, 2003 Actions, and now Minton and Dialog/Hambrecht in the present Action. Applicants respectfully submit that the prosecution of this application has been unnecessarily delayed by the refusal of the Patent Office to perform one search and cite the best prior art that it can find. Applicants have been forced to incur unfair and unreasonable delays and expenses because of the Patent Office’s repeated prior art searches and rejections over newly-cited references - references that have not been any stronger than those cited earlier. Applicants therefore respectfully request that this unfair process end.

All present claim rejections are believed to have been overcome by this Response, and prompt allowance of all pending claims is respectfully requested.

No fee, other than the one-month extension fee authorized separately, is believed due with this response. However, if other fees are due, please charge such fees to Deposit Account No. 50-0310.

Respectfully submitted,

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Steven D. Underwood (Reg. No.)
MORGAN, LEWIS & BOCKIUS LLP
101 Park Avenue
New York, NY 110178-0060
(212) 309-6000